UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,300	06/26/2001	Manoel Tenorio	020431.0840	2345

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EXAMINER
KRAMER, JAMES A

ART UNIT	PAPER NUMBER
3627	

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-22* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-22 and 35 are rejected under 35 U.S.C. 112, second paragraph, as failing to set

forth the subject matter which applicant(s) regard as their invention. In particular, the preamble

of the claims sets forth an apparatus, however the body includes only method step limitations.

Examiner notes that MPEP 2114 states that while features of an apparatus may be recited either

structurally or functionally, claims directed to an apparatus must be distinguished from the prior

art in terms of structure rather than function. In this case there is no structure to the claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-35 rejected under 35 U.S.C. 102(b) as being anticipated by Mathur et al.

(hereinafter Mathur)

Mathur teaches (reference column 3; line 34 – column 5; line 5) that a search engine

provides a search tool which allows users to identify documents of interest using information

stored in the index generated by the search engine. In order to identify documents of interest, a

user generally configures a query using a client computer. The query may contain query terms

which describe, for example, a topic or concept for which the user is interested in finding more

information. For example, if the user is interested in finding information on Thai cooking, the query terms may include the words "Thai" and "cooking."

The user-configured query is then communicated from the user's client computer to a remote server system executing a search engine. Upon receiving the search query, the search engine executing on the remote server identifies documents (or locations of the documents) which match or satisfy the user query based upon information stored in the index used by the search engine. The search engine may use various techniques to determine documents which are relevant to the search query received from the user's client system. Information identifying the relevant documents or their locations determined by the search engine is then communicated from the search engine server to the user's client computer. The user may then use the information received from the search engine to access one or more of the relevant documents.

In a Web environment, the relevant documents may be web pages which may be identified by URLs. Accordingly, the search engine may communicate a list of URLs of interest to the user to the user's client system in response to the user query. The user may then select one or more URLs from the list of URLs and access web pages corresponding to the selected URLs. When the user selects a URL, the URL request is sent to a web server storing the web page corresponding to the URL, and the web server responds by communicating the requested web page to the user's client computer system. The server executing the search engine may act as a conduit forwarding the selected web page received from the web server to the user client computer system.

While conventional search engines simplify the process of identifying documents containing information of interest to a user, they also compromise the user's privacy. This is

because conventional search engine servers frequently track and/or mine the user's browsing

activities and tracking information provided by the user to the search engine. For example,

several conventional search engines mine, without the user's permission, information contained

in user search queries (which may contain information of a sensitive and private nature) provided

to the search engines. Several conventional search engines also track the contents of documents

(e.g. web pages) accessed by the user using the search engine. For example, in a Web

environment, conventional search engines track the web pages accessed by the user, the content

of the web pages, transactions performed by the user using the web pages, and other like

information without the user's permission.

The information mined or tracked by conventional search engines is then used to

ascertain information about the user's interests, likes/dislikes, the user's shopping preferences,

information related to the user's use of the Internet, and other information related to the user and

the user's behavior. Since users generally have a tendency to use a particular search engine to

perform searching, over a period of time, the particular search engine is capable of building a

pretty detailed profile of the user and the user's behavior.

The user information collected by the search engines and the user profile information

built by the search engines, which may be sensitive in nature and contain confidential

information, may then be distributed or even sold by providers of search engines to entities such

as advertising agencies, government agencies, insurance companies, business entities, and the

like. This may result in the user being subjected to unsolicited Spam mail messages, unwelcome

advertisements, credit card fraud, mail fraud, banking fraud, and other unwelcome activities. As

a result, the use of a conventional search engine executing on a remote server can severely

compromise a user's privacy and security. Further, since the information collected by the search engines is typically stored on a server system which is located at a remote location from the user's computer system, the user has very little control on the collection and dissemination of the information.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. 6,128,624 teaches collection and integration of internet and electronic commerce data in a database during web browsing.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Kramer whose telephone number is (703) 305-5241. The examiner can normally be reached on Monday - Friday (8AM - 5PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (703) 305-4716. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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